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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,942	03/05/2002	Geoffrey Fonseca	679.0029USX	6887

7590

07/09/2003

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EXAMINER

ROBERT, EDUARDO C.

ART UNIT	PAPER NUMBER
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3732

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DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,942

Applicant(s)

FONSECA ET AL.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22-24, 29, 34, 35, 40, and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Gueret (U.S. Patent 6,073,634).

Gueret discloses a method of applying a cosmetic to a surface of a human comprising the steps of depositing a cosmetic composition, e.g. mascara, on one or more bristles of an applicator brush, e.g. 1, and transferring the cosmetic composition to the surface of the human, e.g. eyelashes. The bristles can be made from vegetable fiber (see col. 8, lines 41 and 42) which inherently includes polymeric material.

Claims 22-24, 29, 31, 32, 34, 35, 40, 42, 43, and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Castells Ribas (U.S. Patent 6,6314,967).

Castells Ribas discloses a brush for application of mascara on eyelashes. Bristles of the brush are made from vegetable fibers, e.g. cotton. It is noted that cotton is a polymer. Castells Ribas clearly discloses the method used for using mascaras brushes, the mascaras brushes are used by applying a cosmetic material, e.g. mascara, to the bristles of the brush and then applying the cosmetic material with the brush on the eyelashes (see col. 1, lines 22-27). Castells Ribas clearly discloses that this method or procedure is a well known in the art and old.

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Claims 22, 24, 30, 34, 41, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Morganroth (U.S. Patent 4,209,027).

Morganroth discloses a method of treating hair including the steps of depositing a cosmetic material, e.g. hair dye, etc. (see col. 1, lines 20-27) on the bristles of a brush and then applying the material with the brush onto a surface, e.g. hair. The bristles can be made from vegetable fibers. It is noted that vegetable fibers inherently include polymers.

Applicant is reminded that an anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data System, Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). Furthermore, it is well settled that the law of anticipation does not required that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e. all limitation of the claims are found in the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. *Standard Havens Products Inc. v. Gencor Industries Inc.*, 953 F.2d 1360, 21 USPQ 2d. 1321 (Fed. Cir. 1991).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-28 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (U.S. Patent 6,073,634).

Gueret discloses the claimed invention except for the bristles being made from polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide with the structure set forth in claim 38. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the bristles of Gueret of polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide (as set forth in claim 38), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard the average molecular weight of the polylactide (as set forth in claim 38) being about 50,000 to about 250,000, it noted that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 25-28, 33, 36-39, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castells Ribas (U.S. Patent 6,314,967).

Castells Ribas discloses the claimed invention except for the bristles being made from polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide with the structure set forth in

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claim 38. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the bristles of Castells Ribas of polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide (as set forth in claim 38), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard the average molecular weight of the polylactide (as set forth in claim 38) being about 50,000 to about 250,000, it noted that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With regard to claims 33 and 44, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the handle of Castells Ribas of a polymeric material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416

Claims 25-28 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morganroth (U.S. Patent 4,209,027).

Morganroth discloses the claimed invention except for the bristles being made from polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide with the structure set forth in claim 38. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the bristles of Morganroth of polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch

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derivatives, or a polylactide (as set forth in claim 38), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard the average molecular weight of the polylactide (as set forth in claim 38) being about 50,000 to about 250,000, it noted that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Disco, Jr. (U.S. Patent 5,660,273).

Disco, Jr. discloses a method including the steps of depositing a material, e.g. a medicament, on one or more bristles of a brush, and contacting a surface with the bristles having the material thereon. Disco, Jr. discloses the claimed invention except for the bristles being made from polylactide or polycaprolactone, or cotton, etc., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892, attached hereto, for cited art of interest.

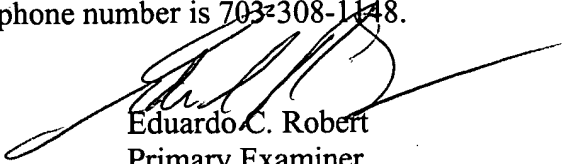
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333.

The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C. Robert
June 24, 2003